REMARKS

The Office Action mailed April 29, 2003, has been received and reviewed. Claims 1-19 are currently pending in the application and stand rejected. Applicant respectfully requests reconsideration of the application in view of the foregoing remarks.

I. 35 U.S.C. § 103(a) Obviousness Rejections Based on Ohno *et al.* in View of Bauer et al.

Claims 1-3, 5, 7-9, and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohno *et al.* ("Ohno") in view of Bauer et al. (6,419,987) ("Bauer"). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103 rejection:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Additionally, a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. BarnesHind/Hydrocurve, Inc.*, 230 U.S.P.Q. 416 (Fed. Cir. 1986). The prior art references cited by the Examiner "would likely *discourage* the art worker from attempting the substitution suggested by [the applicant]." *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 U.S.P.Q.2d 1923 (Fed. Cir. 1990).

Independent claim 1 is drawn to a magnetic printing media for use in a laser and inkjet printer comprising: a base layer; at least one magnetic layer in contact with said base layer, the magnetic layer being adapted to record magnetically encoded information and comprising a layer of homogenous, magnetic material; and at least one ink receptive layer in contact with said at least one magnetic layer, the layer being adapted to absorb laser or inkjet ink thereon. Independent claim 10 is drawn to a magnetic printing media used to verify the authenticity of a document, comprising:

the base layer and magnetic layer(s) as recited in claim 1; and at least one ink receptive layer upon which printed information is recorded, wherein said at least one ink receptive layer is adhered to said at least one magnetic layer and wherein said authenticity of said document is verified by determining whether said magnetic layer contains said magnetically encoded information. Independent claim 17 is drawn to a method of making a magnetically encoded, printed document comprising: providing a base layer that supports said magnetically encoded printed document; adhering a magnetic layer to said base layer; adhering an ink receptive layer to said magnetic layer; recording magnetically encoded information on said magnetic layer; and printing information on said ink receptive layer using an inkjet or laser printer. Independent claims 1, 10, and 17 are not obvious in view of the cited references because the references do not describe each and every element of the claim. Furthermore, the references, when taken as a whole, actually teach away from the present invention.

Ohno discloses a record medium having two magnetic record layers. The record medium is a pre-printed ticket that is fed through a ticket machine to visualize the magnetic information on the magnetic record layers. However, as acknowledged by the Examiner, Ohno does not disclose a magnetic layer that comprises a layer of homogenous, magnetic material. Ohno is completely silent about the types of magnetic materials used and the form in which the magnetic record layers are present. Since Ohno does not disclose that its magnetic record layers comprise a layer of homogenous, magnetic material, Ohno does not describe the magnetic layer of the present invention as recited in claim 1.

Ohno also does not disclose an ink receptive layer that absorbs laser or inkjet ink. To the extent that Ohno discloses an ink receptive layer, Ohno only discloses that the information on the ticket is printed using a "heat-transfer recording system." Column 5, lines 12-14 (emphasis added). Ohno is silent about any other details regarding its ink receptive layer and, therefore, does not disclose that its ink receptive layer absorbs laser or inkjet ink. Ohno also does not disclose that information is printed using a laser or inkjet printer. Furthermore, the record medium of Ohno is not adapted for use in a laser or inkjet printer. In other words, this record medium is not a print medium that can be used in a laser or inkjet printer. Rather, this ticket is pre-

printed with information and magnetic information that is recorded on the magnetic record layers using a heat transfer recording system.

To overcome these deficiencies, the Examiner relies on Bauer as purportedly disclosing "a method for coating a continuous web for use in making printing media wherein the web is used to make magnetic recording layers and ink-jet recording elements." However, Applicant respectfully disagrees with the Examiner's interpretation of Bauer. Bauer discloses a method for coating a continuous web for use in making imaging or printed media. The coated web is made by interacting a first component (viscosity-increasing agent) and a second component (a film-forming polymer) together to increase the viscosity or to gel/crosslink together. Specifically, the viscosity-increasing agent is preapplied onto a "web" through a coating and drying process, followed by coating the film-forming polymer onto the web. As the two components interact with each other during a diffusion process, the viscosity of the solution increases. (*See e.g.*, Bauer at col. 2, lines 2-20). The term "web" is defined as being synonymous with "support" or "sheet," and is defined as a continuous planar polymeric and/or paper material or discrete sections thereof. (*Id.* at col. 2, lines 41-43).

With this background, Bauer goes on to describe application of the first and second component on various media or "webs." In one embodiment, where a web used in making a photographic element, the base/support is described as preferably comprising "a magnetic recording layer," and in a separate embodiment, "in the case of a web used to make an ink-jet recording element, the support typically comprises on at least one surface thereof an ink-receiving (image-recording layer)." (*Id.* at col. 2, lines 57-67). In other words, Bauer simply describes two separate and distinct embodiments for methods to apply a high-viscosity coating onto, on the one hand, photographic elements containing a magnetic recording layer, and on the other hand, application of the high-viscosity coating onto an ink-receiving surface. Bauer does not teach or suggest making a magnetic printing for use in a laser and inkjet printer having "magnetic recording layers and ink-jet recording elements," as suggested by the Examiner.

Bauer does not cure these deficiencies in Ohno because Bauer does not teach or suggest a magnetic printing medium having a magnetic layer that comprises a layer of homogenous, magnetic material together with an ink

receptive layer that absorbs laser or inkjet ink. Therefore, Applicant respectfully submits that the cited references do not teach or suggest all the limitations of independent claims 1, 10, and 17.

The cited references also do not provide a suggestion or motivation to combine. The Examiner states that it would have been obvious to combine Ohno and Bauer use of a heat-transfer system for printing is an "art recognized equivalent" to using laser or inkjet inks in laser or inkjet printing, making the substitution obvious to a person of ordinary skill. (Office Action at pg. 3). However, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01. Nothing in Ohno and Bauer suggests the desirability of having the combination of a magnetic layer comprising a homogenous, magnetic material adjacent to an ink-receptive layer that is adapted to absorb laser or inkjet ink thereon (or methods of making such media). Ohno and Fryberg are not in analogous arts because Ohno is drawn to a magnetic record medium for a heat-transfer system while Bauer is drawn to a method for providing high viscosity coatings on a moving web (alternatively using either an ink-receiving layer or a magnetic recording layer as a base or support).

Finally, even if Ohno and Bauer were combined, the claimed invention would not be produced because the resulting magnetic printing media would not have a magnetic printing medium having a magnetic layer that comprises a layer of homogenous, magnetic material and an ink receptive layer that absorbs laser or inkjet ink. Additionally, Ohno teaches away from the resulting combination because it discloses use of a heat-transfer method to record images on the ticket.

Dependent claims 2, 3, 5, 7-9, 18 and 19 are likewise not obvious in view of the cited references in view of the foregoing arguments.

Claim 2 is further allowable because the combined, cited references do not disclose a base layer that supports the magnetic printing media as it is transported through a laser printer or an inkjet printer.

Claim 3 is further allowable because the combined, cited references do not disclose a base layer having a printable surface.

Claim 5 is further allowable because the combined, cited references do not disclose a base layer and an ink receptive layer both adapted to receive laser or inkjet ink.

Claim 8 is further allowable because the combined, cited references do not disclose magnetically encoded information that is textual and graphical information.

Claim 9 is further allowable because the combined, cited references do not disclose a magnetic layer adhered to a base layer or an ink receptive layer adhered to a magnetic layer.

Claims 18 and 19 are further allowable because the combined, cited references do not disclose transporting the magnetically encoded, printed document through an inkjet or laser printer.

In view of the foregoing arguments, reconsideration and withdrawal of the Section 103 rejection to claims 1-3, 5, 7-9, and 17-19 is respectfully requested.

II. 35 U.S.C. § 103(a) Obviousness Rejection Based on Ohno in view of Bauer and Fryberg

Claim 4 stands rejected under Section 103 as being unpatentable over Ohno in view of Bauer and further in view of Fryberg. Applicant respectfully submits that the rejection of claim 4 is improper because the cited references do not teach or suggest all the limitations of claim 4 and do not provide a suggestion or motivation to combine to produce the claimed invention.

Claim 4 depends from claim 1 and, therefore, includes all the limitations of claim 1. As previously discussed in the foregoing section relative to claim 1, the combination of Ohno and Bauer does not teach or suggest all the limitations of claim 1.

Fryberg does not cure these deficiencies because Fryberg does not teach or suggest a magnetic printing medium having a magnetic layer that comprises a layer of homogenous, magnetic material and an ink receptive layer that absorbs laser or inkjet ink. Therefore, Applicant respectfully submits that the cited references do not teach or suggest all the limitations of claim 4.

The cited references also do not provide a suggestion or motivation to combine. The Examiner states that it would have been obvious to combine Ohno and Fryberg "to modify Ohno's invention to include a coating on the ink receptive layer that increases ink receptivity." (Office Action at pg. 4). However, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01. Nothing in Ohno and Fryberg suggests the desirability of having at least one ink receptive layer that comprises a surface coated onto the ink receptive layer to increase the ink receptivity of the surface. Additionally, Ohno and Fryberg are not in analogous arts because Ohno is drawn to a magnetic record medium while Fryberg is drawn to a print medium.

Furthermore, contrary to the Examiner's stated motivation, nothing in Ohno and Fryberg suggests the desirability of using a surface coated onto the ink receptive layer to retain printing on the ink receptive layer. Finally, even if Ohno and Fryberg were combined, the claimed invention would not be produced because the resulting magnetic printing media would not have a magnetic printing medium having a magnetic layer that comprises a layer of homogenous, magnetic material or an ink receptive layer that absorbs laser or inkjet ink. Additionally, Ohno teaches away from the resulting combination because it discloses use of a heat transfer method to record images on the ticket.

In view of the foregoing arguments, reconsideration and withdrawal of the Section 103 rejection to claim 4 is respectfully requested.

III. Obviousness Rejection Based on Ohno in View of Bauer and Hashiba

Claim 6 stands rejected under Section 103 as being unpatentable over Ohno in view of Bauer and further in view of Hashiba. Applicant respectfully submits that the Section 103 rejection of claim 6 is improper because the cited references do not teach or suggest all the limitations of claim 6 and do not provide a suggestion or motivation to combine to produce the claimed invention.

Claim 6 depends from claim 1 and, therefore, includes all the limitations of claim 1. As previously discussed, Ohno and Bauer dos not teach or suggest all the

limitations of claim 1. Hashiba does not cure the deficiencies in Ohno because Hashiba does not teach or suggest a magnetic printing medium having a magnetic layer comprising a layer of homogenous, magnetic material or an ink receptive layer that absorbs laser or inkjet ink. Therefore, Applicant respectfully submits that the cited references do not teach or suggest all the limitations of claim 6.

In addition to not teaching or suggesting all the limitations of claim 6, the cited references do not provide a suggestion or motivation to combine. The Examiner states that it would be obvious to modify Ohno "to provide the magnetic material selected from material comprising a metal or alloy, as taught by Hashiba." (Office Action at pg. 5). However, the cited references do not suggest the desirability of such a combination. Nothing in Ohno suggests the desirability of using the recited materials in a magnetic printing media and Hashiba does not suggest the desirability of using the listed materials in a magnetic printing media. Furthermore, as previously discussed, even if Ohno and Hashiba were combined (along with Bauer), the claimed invention would not be produced because the resulting magnetic printing media would not have a magnetic printing medium having a magnetic layer that comprises a layer of homogenous, magnetic material and an ink receptive layer that absorbs laser or inkjet ink.

In view of the foregoing arguments, reconsideration and withdrawal of the Section 103 rejection to claim 6 is respectfully requested.

IV. Obviousness Rejection Based on Brosow in View of Bauer and Ohno

Claims 10-15 stand rejected under Section 103 as being unpatentable over Brosow in view of Bauer and further in view of Ohno. Applicant respectfully submits that the cited references do not teach or suggest all the limitations of the rejected claims and do not provide a suggestion or motivation to combine.
As amended herein, Claim 10, is not rendered obvious by the cited references because the cited references do not teach or suggest all the limitations of claim 10. As previously discussed, the combination of Ohno and Bauer do not teach or suggest a magnetic printing media having a magnetic layer that comprises a layer of homogenous, magnetic material and an ink receptive layer that absorbs laser or inkjet ink, or methods of making the same.

Brosow does not cure these deficiencies because Brosow utilizes fibers or filaments coated with a magnetic or magnetizable material. These fibers are embedded in a base material and are not formed in a layer. Brosow and Ohno (as well as Bauer) also do not teach or suggest that the base layer, magnetic layer, and ink receptive layer are adhered to one another. Rather, Ohno is silent about how its layers are formed while the magnetic material in Brosow is embedded in the base material.

The Examiner asserts that Brosow discloses the claimed invention "except for the particular arrangement of the layers of the magnetic media." (Office Action at pg. 5). However, Brosow does not teach or suggest a base layer, at least one magnetic layer, or an ink receptive layer. Specifically, the base material in Brosow is not a discrete layer upon which the other layers are adhered, the magnetic fibers or filaments do not form a layer, and an ink receptive layer is not disclosed.

The cited references also do not provide a motivation to combine. The Examiner states that it would have been obvious to modify Brosow "to include a printing media having the disclosed arrangement, as taught by Ohno, to provide a secure document that contains encoded information that can not be easily reproduced." (Office Action at pg. 6). However, nothing in Brosow and Ohno suggests the desirability of such a combination. Furthermore, even if Brosow and Ohno were combined, the claimed invention would not be produced because the resulting magnetic layer would not comprise a layer of homogenous, magnetic material and the base layer, magnetic layer, and ink receptive layer would not be adhered to one another.

Dependent claims 11-15 include all the limitations of claim 10 and, therefore, are allowable, *inter alia*, as depending on allowable claim 10.

Claim 12 is further allowable because the cited references do not teach or suggest that the magnetically encoded information is identical in content to the printed information.

Claim 13 is further allowable because the cited references do not teach or suggest that the magnetic layer and the ink receptive layer are adapted to record encoded information and printed information simultaneously.

In view of the foregoing arguments, reconsideration and withdrawal of the Section 103 rejections to claims 10-15 is respectfully requested.

V. Obviousness Rejection Based on Brosow in View of Ohno and Further in View of Fryberg

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Brosow in view of Ohno and further in view of Fryberg. Applicant respectfully submits that the cited references do not teach or suggest the limitations of claim 16 and do not provide a suggestion or motivation to combine. Claim 16 depends on claim 10 and, therefore, includes all the limitations of claim 10. As previously discussed, Brosow and Ohno do not teach or suggest a magnetic layer that comprises a layer of homogenous, magnetic material or a base layer, magnetic layer, and ink receptive layer that are adhered to one another. Fryberg also does not teach or suggest these limitations and, therefore, does not cure the deficiencies in Brosow and Ohno.

The cited references also do not provide a motivation to combine. The Examiner states that it would have been obvious to combine Ohno, Brosow, and Fryberg "to retain the printing received on the surface that would diminish over time without the use of the coating." (Office Action at pgs. 6-7). However, nothing in Brosow, Ohno, and Fryberg suggest the desirability of a base layer of a magnetic printing media having a coated surface adapted to increase ink receptivity. Furthermore, even if the cited references were combined, the claimed invention would not be produced because the resulting magnetic layer would not comprise a layer of homogenous, magnetic material and the base layer, magnetic layer, and ink receptive layer would not be adhered to one another.

In view of the foregoing arguments, reconsideration and withdrawal of the Section 103 rejections to claim 16 is respectfully requested.

CONCLUSION

In view of the foregoing amendments, and further in view of the arguments made, it is believed that this application is now in condition for allowance. Reconsideration and early Notice of Allowance is respectfully requested. Should the Examiner determine that additional issues remain that might be resolved by a telephone conference, she is respectfully invited to contact Applicant's undersigned attorney.

Respectfully Submitted,

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